

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, the specification has been amended to correct a number of grammatical and/or typographical errors which appear to have resulted from the translation of the French PCT application into the English language. Such corrections are obvious and minor in nature. The specification has also been amended to include the appropriate heading for the brief description of the drawings and insert an abstract on a separate sheet of paper. Further, the specification has been amended to replace the originally filed Sequence Listing with a substitute Sequence Listing and to include the sequence identifiers at the appropriate locations throughout the specification.

It is noted that, as in parent application Serial No. 08/379,452, the nucleotide sequence of GenBank accession number M73260 has been added to the subject application as SEQ ID NO: 43. The addition of this sequence does not constitute new matter nor does it violate the written description requirement of 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to one of ordinary skill in the art that the inventors had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim

language. *See, e.g., Behr v. Talbot*, 27 U.S.P.Q.2d 1401, 1407 (B.P.A.I. 1992); *Ex Parte Harvey*, 3 U.S.P.Q.2d 1626,, 1627 (B.P.A.I. 1987).

The originally filed application plainly sets forth the nucleotide sequence of the human adenovirus type 5 as being that sequence deposited in GenBank as accession number M73260. *See*, for example, pages 4, 10, 19 and 24 of the originally filed application. Thus, reference to the GenBank accession number shows that applicants were in possession of the nucleotide sequence for human adenovirus type 5. Further, as can be seen from the Declaration by Dr. Mehtali (one of the inventors of the subject application) which was filed in application Serial No. 08/379,452 on June 3, 1999 (a copy of this Declaration is enclosed herewith for the Examiner's convenience), there has been no changes to the human adenovirus type 5 nucleotide sequence since it was originally deposited with GenBank and assigned accession number M73260.

The nucleotide sequence having GenBank accession number M73260 was originally deposited by Dr. Chroboczek's research group and described in the following journal article: Chroboczek et al., *Virology*, 186(1):280-285 (1992). A copy of this journal article was filed in application Serial No. 08/379,452 and was cited in the Information Disclosure Statement filed on September 9, 1999. One of the inventors of the present application, Dr. Mehtali, contacted Dr. Chroboczek and obtained a copy of the human adenovirus type 5 nucleotide sequence which was deposited with GenBank and assigned accession number M73260. The nucleotide sequence obtained from Dr. Chroboczek was compared with the nucleotide sequence currently provided by GenBank on-line via the Internet. As a result of

this comparison it has been determined that there have been no changes to the human adenovirus type 5 nucleotide sequence. Moreover, Dr. Chroboczek indicated that she was not aware of any changes to the nucleotide sequence.

Further, applicants have also contacted GenBank to verify that no changes have been made to the human adenovirus type 5 nucleotide sequence having accession number M73260. GenBank has indicated that the record for accession number M73260 had been updated in 1996, however, this update reflected the changes which were made by the International Committee on Taxonomy of Viruses. The actual nucleotide sequence, however, was not changed.

In view of the evidence set forth above, the human adenovirus type 5 sequence added by the foregoing amendment is identical to the nucleotide sequence which was disclosed by GenBank under accession number M73260 at the time the present application's earliest French priority application was filed. Accordingly, no new matter has been added and the application fully complies with the requirements of 35 U.S.C. § 112, first paragraph.

Additionally, by the present amendment, claim 58 has been canceled without prejudice or disclaimer and new claim 61 has been added. Claim 61 is essentially drawn the subject matter of claim 58 but written in independent form. No new matter has been added by the foregoing amendment.

Turning now to the Official Action, the Examiner has indicated that the Information Disclosure Statement file on September 9, 1999 fails to comply with 37 C.F.R. §

1.98(a)(2) since copies of several of the references were not submitted. Applicants have filed, concurrently herewith, another Information Disclosure Statement re-listing the references which the Examiner noted were not considered and providing copies of these references as well.

The Examiner has raised several informalities regarding the specification including the requirement of an abstract on a separate sheet and a heading for the brief description of the drawings. By the foregoing amendment, the specification has been amended to include the appropriate heading for the brief description of the drawings and insert an abstract on a separate sheet of paper.

Furthermore, the Examiner has indicated that the application fails to comply with the Sequence Listing requirements. By the present amendment, the specification has been amended to replace the originally filed Sequence Listing with the substitute Sequence Listing which was filed in parent application Serial No. 08/379,452. As suggested by the Examiner, the supporting documentation and explanation as provided *supra* has been provided herewith to avoid any issue of new matter. Additionally, applicants have also concurrently filed herewith, a Request to Use the Computer Readable Form From the Parent Application Pursuant to 37 C.F.R. § 1.821(e) as well as a Declaration Pursuant to 37 C.F.R. §§ 1.821-.825.

In view of the above, the Examiner's objections to the specification have been obviated.

Claim 58 has been objected to under 37 C.F.R. § 1.75(c) as being of improper form for allegedly failing to further limit the subject matter of a previous claim. This rejection is respectfully traversed. However, to expedite prosecution in the subject application and in accordance with the Examiner's suggestions, claim 58 has been canceled by the present amendment and the subject matter described therein has been rewritten in independent form as new claim 61. Hence, the Examiner is respectfully requested to withdraw this objection.

The Examiner has also provisionally rejected claims 56-59 under the judicially created doctrine of double patenting over claim 57 of copending application Serial No. 09/421,935. This rejection is respectfully traversed. However, the Examiner is respectfully requested to hold this rejection in abeyance until there is an indication of allowable subject matter in one of the two copending application. At such time, the Examiner should withdraw the provisional rejection in the application with allowable subject matter and thus permit the application to issue as a patent, and then convert the "provisional" rejection in the other application into a double patenting rejection.

Lastly, claims 56-59 have been rejected under the judicially created doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 2 and 18 of U.S. Patent No. 6,040,174. This rejection is respectfully traversed.

An "analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination." M.P.E.P. § 804 (citing *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991) and *In re Longi*, 759 F.2d 887 (Fed.

Cir. 1985)). "When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." M.P.E.P. § 804.

The claims of the subject application are not an obvious variation of claims 2 and 18 of the '174 patent since the claimed recombinant adenovirus of the subject application, although they can be produced by using the cells and methods claimed in the '174 patent, can be produced "by passage in any complementation cell line providing *in trans* the functions for which the adenoviral vector . . . is defective." Page 15, lines 7-10, of the subject application; *see also* page 15, lines 15-17, of the subject application.

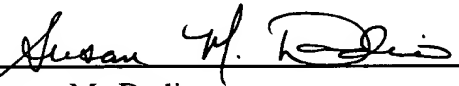
Therefore, withdrawal of the obviousness-type double patenting rejection is respectfully traversed.

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions relating to this response, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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Date: October 27, 2000